UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/175,589	10/20/1998	ANDREA M. JACOBSON	12369.5US01	7081

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EXAMINER
COLBERT, ELLA

ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/175,589	JACOBSON, ANDREA M.
	Examiner	Art Unit	
	Ella Colbert	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 September 2004</u>.

2a)☐ This action is **FINAL**.　　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some *　c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　　　application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-23 are pending in this communication filed 6/09/04 as Amendment and

Extension of Time and 09/09/04 as RCE. Claims 1, 13, 17, and 20 have been amended

and claim 23 has been added.

2.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

06/09/04 has been entered.

Claim Rejections - 35 USC § 112

3   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Claim 1, line 6 reads "the pre-determined network

security policy". It is very vague and unclear in the claim language what Applicant

means by "pre-determined network security policy". Does applicant mean "network

security" rules or requirements or user rights?

Line 8 reads "sending the electronic record to a recipient; and". It is unclear and

cannot be determined where the electronic record is being sent from to the recipient. Is

the electronic record being sent from the network or from another user and who or what

is automatically denying a request to delete the electronic record before expiration ..."?

Claim 5, reads "... comprises a computer having a registry and a user profile,

wherein creating the electronic tag comprises generating a reference code, wherein the

electronic tag is generated at least in part as a function of at least one of the registry,

the user profile, and the reference code." This claim limitation is confusing as written.

The Examiner is unable to determine what Applicant is trying to say or to claim. There

appears to be some wording missing in the claim limitation.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over "http://

www.ustrim.com/trim/page 31.htm", hereafter ustrim in view of (US 6,108,688) Nielsen.

With respect to claim 1, USTrim teaches, creating an electronic tag that uniquely

identifies the electronic record, the electronic tag being associated with a specified time

period for compliance with the pre-determined network security policy (see "publishing

records on the WWW" page 1 and "Security and Privacy of Records" page 2); storing

the at least one electronic tag in a central repository (see "Record Navigation" page 1,

"WWW Access to TRIM DataBases" page 1, and "Publishing Records on the WWW"

page 1).

Ustrim failed to teach, sending the electronic record to a recipient. Nielsen

teaches, sending the electronic record to a recipient (col. 2, lines 57-66). It would have

been obvious to one having ordinary skill in the art at the time the invention was made

to send the electronic record to a recipient and to modify in Ustrim in view of Ustrim's

teachings of an electronic tag and electronic documents and because such a

modification would allow Ustrim to be addressed to a recipient and to arrive at the

recipient's computer terminal with minimal information about the message.

Ustrim teaches, automatically denying a request to delete the electronic record

before expiration of the specified time period associated with the electronic tag (page 1,

"Retention & Disposal of Records" (also see fig. of screen shot). Ustrim did not

expressly disclose automatically denying a request to delete the electronic record

before expiration of the specific time period. However, Ustrim shows in a figure of the

screen shot of a 2 year archive and destroying after 6 years. Nielsen teaches, a date

and time in fig. 2. It is well known in the art of electronic mail and network security that

electronic mail documents are either deleted, purged, archived or destroyed after a

period of time.

7.   Claims 2-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Ustrim and Nielsen in view of (EP O346556) Mourier.

With respect to claim 2, Ustrim and Nielsen failed to teach, further comprising

deleting the electronic record and selectively deleting the at least one electronic tag.

Mourier teaches, further comprising deleting the electronic record and selectively

deleting the at least one electronic tag (col. 9, lines 47-55 and lines 59-68 and fig. 19B).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to delete the electronic record and selectively delete the at least

one electronic tag and to modify in UStrim because such a modification would allow

UStrim to have the tag transferred into the "To Be Answered" file and deleted from the

"To Be Assigned" file (purging the electronic record comprising the steps of deleting the

electronic record).

With respect to claim 3, UStrim teaches, further comprising storing the electronic

record ("WWW Access to Trim DataBase" page 1).

With respect to claim 4, Ustrim teaches, determining whether the request is

consistent with the network security policy ("Security and Privacy of Records" page 1).

With respect to claim 5, Ustrim and Nielsen failed to teach, wherein the electronic

tag is generated at least in part as a function of at least one of the registry, the user

profile, and the reference code. Mourier teaches, wherein the electronic tag is

generated at least in part as a function of at least one of the registry, the user profile,

and the reference code (col. 4, lines 12-65). It would have been obvious to one having

ordinary skill in the art at the time the invention was made to have the electronic tag

generated at least in part as a function of at least one of the registry, the user profile,

and a reference code and to combine Ustrim's electronic tag that uniquely identifies the

electronic record with Mourier's network user's user profile, reference code, and

electronic tag being generated at least in part as a function of at least one of the

registry, the user profile, and the reference code because such a combination would

allow Ustrim to manage electronic mail without wasteful memory space and without

having a time-consuming process to retrieve saved electronic mail.

With respect to claim 6, UStrim and Nielsen failed to teach, generating the

reference code comprises reading the electronic record. Mourier teaches, generating

the reference code comprises reading the electronic record (page 7, lines 16-47). It

would have been obvious to one having ordinary skill in the art at the time the invention

was made to generate the reference code comprising reading the electronic record and

to modify in UStrim because such a modification would allow Nielsen to have a special

memory section within his machine, memory section he may access on a read/write

basis.

With respect to claim 7, this dependent claim is rejected for the similar rationale

given for claim 6.

With respect to claim 8, UStrim and Nielsen failed to teach, wherein the index

code identifies the contents of the electronic record and the recipient of the electronic

record.   Mourier teaches, an index code identifying the contents of the electronic record

and the recipient of the electronic record (page 7, lines 1-56). It would have been

obvious to one having ordinary skill in the art at the time the invention was made to

have the index code identify the contents of the electronic record and to modify in

UStrim because such a modification would allow UStrim to have a command that sorts

(index) the files by updated dates (index code).

With respect to claim 9, UStrim failed to teach, wherein the index code identified

the contents of the electronic record and the recipient of the electronic record. Nielsen

teaches, wherein the index code identified the contents of the electronic record and the recipient of the electronic record (col. Col. 1, lines 7-41). The nature of E-mail does not entitle any patentable weight and is considered a design choice.

With respect to claim 10, UStrim and Nielsen failed to teach, reading a stored electronic tag; and generating an electronic tag in response to accessing an electronic record. Mourier teaches, reading a stored electronic tag; and generating an electronic tag in response to accessing an electronic record (Page 8, lines 9-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to read a stored electronic tag and generating an electronic tag in response to accessing an electronic record and to modify in UStrim because such a modification would allow UStrim to have a subject and to have a message with the sender code and a recipient code.

With respect to claim 11, this dependent claim is rejected for the similar rationale given for claim 9.

With respect to claim 12, this dependent claim is rejected for the similar rationale given for claims 5 and 6.

With respect to claim 13, UStrim and Nielsen failed to teach, a computer system comprising at least one processor and at least one memory. Mourier teaches, a computer system comprising at least one processor and at least one memory (page 3, lines 1-18 and lines 46-49). This independent claim is rejected for the similar rationale as given above for claim 1.

With respect to claim 14, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 15, this dependent claim is rejected for the similar rationale given for claim 4.

With respect to claim 16, this dependent claim is rejected for the similar rationale given for claim 5.

With respect to claim 17, this independent claim is rejected for the similar rationale given for claim 1.

With respect to claim 18, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 19, this dependent claim is rejected for the similar rationale given for claim 3.

With respect to claim 20, this dependent claim is rejected for the similar rationale as given above for claim 4.

With respect to claim 21, this independent claim is rejected for the similar rationale given for claim 5.

With respect to claim 22, this independent claim is rejected for the similar rationale given for claim 6.

With respect to claim 23, this independent claim is rejected for the similar rationale as given above for claims 1, 13, and 17.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

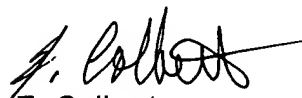Keller et al (US 5,906,656) disclosed electronic distributions (electronic mail).

Landfield et al (US 5,632,011) disclosed electronic mail management.

Inquiries

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ella Colbert whose telephone number is 703-308-7064.

The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

/E. Colbert
November 26, 2004